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EXAMINER

STEELMAN, MARY J

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/714,156

Applicant(s)

OGURA, KOUJIROU

Examiner

Mary J. Steelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to initial filing, priority papers, and preliminary amendment A, and IDS, filed 11/17/2000.
2. Per Applicant's request, claims 1 and 12 have been amended. Claims 1-15 are pending.

#### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

4. The information disclosure statement filed 11/17/2000 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because an English translation is not provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1). Examiner has considered the Abstract only, which is provided in English.

#### ***Drawings***

5. Figure 10, upper right hand corner, recites "1 / 1", should be --11--, for SALES OFFICE SERVER.

#### ***Specification***

6. Page 1, line 20, recites "is cashed and used...", should be --is cached and used....--.

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Replace “cashed” with “cached”.

7. The use of trademarks JAVA & CORBA have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

8. Claims 6 and 14 are objected to because of the following informalities:

Claim 6 recites, “The client according to claim 2...”, should be –The client according to claim 3...-- Change ‘2’ to ‘3’. For examination purposes, Examiner will treat claim 6 as if it was dependent on claim 3.

Claim 14 recites, “The system according to claim 13...”, should be –The method according to claim 13...-- For examination purposes, Examiner will treat claim 14 as if it was a ‘method’ claim, dependent on claim 13.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 4, 5, 6, 7, 8, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Trademark or Trade Name as a Limitation in the Claim

Claims 4, 5, 6, and 14 contain the trademark/trade name JAVA. Claim 9 contains the trademark/trade name CORBA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade names are used to identify/describe 'byte code programming language' and 'unrelated programming language objects interoperating over a network' and, accordingly, the identification/description is indefinite.

11. Claims 1-11, 13-14, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, page 19, line 20, claim 13, page 23, line 3, and claim 15, page 24, line 3, recite, "...updating the applet when a comparison process outputs..." It is unclear that the client applet is updated to the latest version. Amending the claim to recite, "...updating the client applet to the latest version when a comparison process outputs..." can cure this.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6360366 to Heath et al.

Per claims 1, 13, and 15:

-a server having an applet storage unit storing an applet of a latest version, and a version number storage unit storing a version number of an applet stored in the applet storage unit;

(See figure 2B. Col. 1, lines 63-66, "...maintaining on a server the components of an application program, each having a version identification and maintaining a catalog of components with the version identifications." Per Microsoft Computer Dictionary, Fifth Edition, page 31, a applet "...is a program that can be downloaded over the Internet and executed on the recipient's machine..." See figure 7A and col. 8, lines 28-31, "...components are downloaded to update the application program without leaving the Web browser at 710 and the program is executed at 712." An application program can include an applet.)

-a client having a version number information storage unit performing a process based on the applet read from said server, and storing version number information about the applet, a comparison unit reading the version number information about the applet of the latest version from the version number storage unit when a predetermined event occurs, and comparing the read information with the version number information stored in the version number information storage unit, and an update unit reading the applet of the latest version from the applet storage unit and updating the applet when a comparison process outputs a non-matching result.

(See figure 4D, #416, #418, #420. Col. 2, lines 1-11, "The application program is further maintained at a client. In response to a call to the server from the client, the server is caused to

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download the catalog to the client and the client compares the version identifications between the components maintained on the server...and the components maintained on the client. The application program on the client is updated by downloading from the server to the client the selected components for which the version identifications do not match. The updated application program is then executed on the client.”)

Per claim 2:

-an applet storage unit updating an applet, and storing an applet of a latest version; (See figure 3A. Col. 6, lines 6-8, “...the launcher at 308 engages the server to download the required components for a proper update...”)

-a version number storage unit storing a version number of an applet stored in said applet storage unit, wherein; (Col. 3, lines 19-21, “...version identifications of the components for the updated application program is stored on the client to be used in a subsequent update.”)

-version number information is read from said version number storage unit at a version number information read request, and is transmitted to a client. (See figure 4D. Col. 6, lines 57-64, “The process for identifying the individual component files to download from the server begins at 416.

At 416, the launcher reads the next component file name and version number or identification from the retrieved catalog file of the latest component versions made available on the server.

Each component version number is compared at 418 with the current component version numbers listed in a previous catalog file representation stored in cache on the client.”)

Per claim 3:

-a version number information storage unit performing a process based on the applet read from said server, and storing version number information about the applet; (Col. 6, lines 15-18,

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“Information in the catalog file, which at least includes the updated list of components and version numbers on the client, is stored at 317 in cache on the client until the subsequent version update.”)

-a comparison unit reading the version number information about the applet of the latest version from said version number storage unit when a predetermined event occurs, and comparing the read information with the version number information stored in said version number information storage unit; (Col. 6, lines 59-64, “At 416, the launcher reads the next component file name and version number or identification from the retrieved catalog file of the latest component versions made available on the server. Each component version number is compared at 418 with the current component version numbers listed in a previous catalog file representation stored in cache on the client.” Also, see col. 7, lines 59-63, “...the launcher is configured to run an update on a periodic basis, such as on a daily, weekly, or monthly basis...checks to determine if a new update is due...” (predetermined event occurs))

-an update unit reading the applet of the latest version from said applet storage unit and updating the applet when a comparison process outputs a non-matching result. (Col. 2, lines 7-10, “The application program on the client is updated by downloading from the server to the client the selected components for which the version identifications do not match.”)

Per claims 4, 5, 6 and 14:

-said applet is a (JAVA) applet. (Per Microsoft Computer Dictionary, Fifth Edition, page 31, an applet “...is a program that can be downloaded over the Internet and executed on the recipient’s machine. Applets are often written in the JAVA programming language and run within browser



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software...” A trademark word used in a claim renders the claim indefinite, as the owner of the trademark may change the meaning, at will.)

Per claims 7 and 8:

-predetermined event occurs when the applet becomes active. (See figure 3A. Col. 6, lines 12-18, “The updated and verified application program is launched and executed (becomes active) at 314 followed by any post-launch activities (predetermined event) at 316 also defined in the catalog file. Information in the catalog file, which at least includes the updated list of components and version numbers on the client, is stored (predetermined event) at 317 in cache on the client...”)

Per claim 9:

-communications are established between said server and said client. (Figure 3A, #302. Col. 5, lines 49-50, “...the catalog file is retrieved at 302 from the server in response to a call from the client.”)

Per claims 11 and 12:

-said version number information storage unit is main memory or a disk. (See figure 3A, #300, downloadable catalog file stored on server (memory). Col. 5, lines 10-20, “The process first involves packaging a catalog file in the server. The catalog file is downloadable from the server to a client using standard network transfer protocol...the catalog file includes...a version identification...The components themselves may also be included within the catalog file...”)

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,360,366 to Heath et al. Heath disclosed a client server networked environment, with an “application program...maintained at a client. In response to a call to the server from the client, the server is caused to download...the client compares the version...the client is updated by downloading...selected components...” (col. 2, lines 1-8).

Heath failed to disclose the “server is a banking operation center, and said client is a branch office terminal device”. However, it is well known that client / sever networks are used in all type of businesses, including banking. A common example of an applet maintained client-side, is a cookie. It is well known that cookies are downloaded / updated from a server and reside in a client computer. Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention to have modified Heath’s invention, an application program, maintained at the client, receiving an update, responsive to a call from the client to the server, by including the option of the environment being a bank operation and branch office terminal devices because client side programs in a networked environment are well known in the banking industry.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (703) 305-4564. The

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examiner can normally be reached Monday through Thursday, from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (703) 305-4552.

The fax phone numbers are (703) 872-9306 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Mary Steelman



10/09/2003



**ANTONY NGUYEN-BA  
PRIMARY EXAMINER**